

REMARKS

Claims 1-6 and 12-35 are pending in the application.

Independent claims 1, 12 and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention at the time the application was filed. The Examiner states that the recited term "in an absence of additionally added gases" is not supported by the specification. Applicant disagrees and requests reconsideration.

Applicant directs attention to MPEP § 2163.02 which indicates that determining compliance with the written description requirement of § 112 is to be based upon what is reasonably conveyed by the specification to one skilled in the art at the time the application was filed. Applicant additionally points out that the terminology in the specification need not be the same as the terminology utilized in the claims so long as the specification conveys with reasonable clarity that the inventor was in possession of the invention as it is now claimed. With respect to a claim element which is added by amendment, a rejection of such claim under the written description requirement of § 112 is proper when the amendment involved "a departure from, addition to, or deletion from the disclosure of the application as filed".

As noted by the applicant in response to the May 24, 2002 Office Action, applicant's specification as originally filed describes providing a feed gas to an ozone generator to form ozone (see, for example, page 4, line 14 through page

5, line 10). The description further indicates providing a feed gas purity of at least 99.999% oxygen (by volume). As explained in this portion of the specification, the high purity oxygen feed gas is utilized to provide a reduced concentration of nitrogen within the feed gas to decrease or avoid detrimental effects that can occur at higher nitrogen concentrations. The specification additionally indicates with reference to Fig. 1, that a feed gas source 22 is provided and a feed gas 24 is flowed from source 22 to ozone generator 18. A person of ordinary skill in the art when considering Fig. 1 and accompanying text at page 4, line 14 through page 5, line 10, would understand that the invention encompasses embodiments as recited in the independent claim where a feed gas comprising at least 99.999% O₂ is fed through an ozone generator in an absence of additionally added gases. The recited phrase "in an absence of additionally added gases" does not depart from, add to, or delete from the disclosure as originally filed. Accordingly, applicant respectfully requests withdrawal of the Examiner's § 112, first paragraph, rejection of independent claims 1, 12 and 25 in the Examiner's next action.

Claims 1, 12 and 25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner states that the limitation "in an absence of additionally added gases, feeding the feed gas through an ozone generator to generate ozone from the feed gas" is indefinite because it attempts to claim the invention by excluding what the inventors did not invent. The Examiner is reminded by direction to

MPEP § 2173.03 that inquiry regarding the definiteness of a claim is not conducted in a vacuum but in light of the content of the application disclosure, the teachings of prior art, and the claim interpretation that would be given by one possessing ordinary level of skill in the art. As indicated in applicant's specification at, for example, page 2, lines 1-10, prior art methods typically utilize a feed gas which is generally about 99.9% oxygen with the remainder being mostly nitrogen. As further indicated, prior art methods may additionally spike an increased concentration of nitrogen into the feed gas. As discussed above, the present invention overcomes drawbacks of utilizing lower purity feed gas as set forth in the specification at, for example, page 4, line 18 through page 5, line 10. Applicant's specification specifically indicates that utilization of a feed gas comprising high purity oxygen in contrast to the prior art can overcome limitations of a less pure feed gas. Accordingly, applicant's specification distinctly points out advantages of using a high purity feed gas which does not comprise added or spiked gases. The recited feeding the feed gas in an absence of additionally added gases particularly points out the subject matter which the applicant regards as the invention. The rejection under 35 U.S.C. § 112, second paragraph, is therefore improper. Applicant respectfully requests withdrawal of the § 112, second paragraph, rejection of claims 1, 12, and 25 in the Examiner's next action.

Applicant notes the Examiner's indicated allowability of the subject matter of claims 1-6 and 12-35 in the event the rejections under 35 U.S.C. § 112 were overcome. For the reasons discussed above, claims 1-6 and 12-35 comply with

the requirements of 35 U.S.C. § 112, first and second paragraphs. Accordingly, applicant respectfully requests formal allowance of claims 1-6 and 12-35 in the Examiner's next action.

Respectfully submitted,

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